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60,469-033
OT-4776

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application: Mello
Serial No.: 09/818,016
Filed: 3/26/2001
Group Art Unit: 3623
Examiner: Van Doren, Beth
For: SYSTEM FOR REMOTELY MANAGING ELEVATOR
MECHANIC SERVICE ROUTINE

REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This is in reply to the Examiner's Answer mailed April 3, 2006.

It is imperative to resist the temptation to look at a reference with an Applicant's combination already in mind to determine if another feature (from Applicant's teachings) might somehow fit with the teachings of a reference. The reference must be considered on its own merits and for its own teachings to determine whether there is any motivation for making a combination that it does not teach.

In this case, when one considers the actual teachings of the *Lesaint, et al.* reference, there is no motivation to modify those teachings as contended by the Examiner. There is no motivation to modify a scheduling technique to include a billing function, for example. Additionally, the *Lesaint, et al.* reference teaches away from allowing a field technician to expressly reject a special service request (assuming that the *Lesaint, et al.* reference even teaches handling a special service request).

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The Examiner's position regarding claims 12 and 20 does not provide any explanation for how *billing* information in any way enhances the *scheduling* algorithm of the *Lesaint, et al.* reference. Billing and scheduling are normally very distinct functions. That is why the *Lesaint, et al.* reference is silent about the former and focused on the latter.

Only after reading about Applicant's recognized usefulness of the claimed combination, was the Examiner able to come up with supposed motivation for modifying the *Lesaint, et al.* reference to include billing information. The Examiner contends that modifying the *Lesaint, et al.* reference to become consistent with Applicant's invention would provide some efficiency "allowing for quicker compensation." But that is taking things in the abstract and essentially ignoring the requirement that a modification to a reference must provide some benefit within the context of the teachings of the reference – not some benefit in the abstract or for some purpose that has nothing to do with what the reference is focused on.

There is no dispute that the *Lesaint, et al.* reference is directed solely to a scheduling algorithm. That algorithm will not in any way be enhanced by adding a completely unrelated function of automatically generating billing information. Therefore, there is no motivation for the modification and the Examiner's proposed modification cannot be made.

The proposed combination of the *Lesaint, et al.* reference and the *Bergeron, et al.* reference similarly does not provide any benefit to the scheduling algorithm of the *Lesaint, et al.* reference. Adding a rejection or acceptance feature from the *Bergeron, et al.* reference does not provide any benefit to the arrangement in the *Lesaint, et al.* reference because it does not make that system any more efficient to reach its intended objectives. The *Lesaint, et al.* reference teaches presenting already-scheduled assignments to an individual. It does not contemplate a special service request outside of the already generated schedule. Allowing an individual to

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refuse a scheduled assignment after it has been scheduled seems contrary to the intentions of *Lesaint, et al.* reference. The disclosed technique of that reference automatically assigns a schedule of tasks once an appropriate individual "reports in," (column 4, line 66) or "calls in," (column 5, line 22). There is no option of taking a special service request. Adding such a feature does not fit within the approach of the *Lesaint, et al.* reference and the combination cannot be made.

There is no motivation to modify the scheduling algorithm of the *Lesaint, et al.* reference as proposed by the Examiner and therefore, no *prima facie* case of obviousness.

Additionally, even if the combination could be made, the result is not the same as what is recited in claim 4. The references do not teach anything about taking information from a tracking device and using that to update the status of a task. It is important to note that not just any update will satisfy claim 4. Instead, a particular arrangement where a tracking device provides information used for such an update is claimed. The cited references are silent regarding such an approach and that is another reason why there is no *prima facie* case against claim 4.

The last point worth mentioning on reply is what appears to be some conflict over the interpretation of claim 13. That claim recites a special service request as a separate item from the recommended list of tasks to complete during a workday. The scheduled tasks of the *Lesaint, et al.* reference may correspond to the latter but do not contemplate the former. The Examiner seems to be overlooking the distinction drawn in claim 13 and blending them together. Applicant contends that claim 13 has a similar scope to claim 1 at least with respect to the distinction between a special service request and a recommended list of tasks for a workday and therefore, the Examiner's positions with regard to claims 1 and 13 are inconsistent. The Examiner properly admits that the *Lesaint, et al.* reference is silent regarding how a special

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service request would be handled when discussing claim 1. The same analysis applies to claim 13. Either way, there is no *prima facie* case against claim 13 as explained in Appellant's opening brief.

Appellant respectfully requests that the rejections be reversed.

Respectfully submitted,

CARLSON, GASKEY & OLDS, P.C.

June 5, 2006
Date



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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the enclosed **Reply Brief** for application serial number 09/818,016 is being facsimile transmitted to the 571-273-8300 on June 5, 2006.



David J. Gaskey

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